

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. Claims 1-44 remain pending. This application has been carefully reviewed in light of the Official Action mailed January 29, 2004. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 1-13, 14-26, 27-39 and 40-43 stand rejected as obvious over U.S. Patent No. 6,236,971 ("Stefik") in view of U.S. Published Application No. 2002/0078377 ("Chang"). Applicant respectfully traverses this rejection.

With respect to claim 1, this claim recites storing a reference to an object in a repository, wherein the object is an invokable software object; performing an operation to store a duplicate of the reference to the object in a second repository, wherein the first operation is in accordance with a first privilege granted as defined by a permission. These permissions may define the ability of a user to perform operations on these objects. Thus, invokable objects may be shared between resources and manipulated by users according to a set of privileges.

In order to establish a prima facie case of obviousness, the Examiner must show: that the prior art references teach or suggest all of the claim limitations; that there is some suggestion or motivation in the references (or within the knowledge of one of ordinary skill in the art) to modify or combine the references; and that there is a reasonable expectation of success. M.P.E.P. 2142, 2143; In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner must explain with reasonable specificity at least one rejection – otherwise, the Examiner has failed procedurally to establish a prima facie case of obviousness. M.P.E.P. 2142; Ex parte Blanc, 13 U.S.P.Q.2d 1383 (Bd. Pat. Application. & Inter. 1989). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Inter. 1986).

Applicant respectfully submits that the Examiner has failed to properly point out any motivation to combine the references. As to motivation to combine, the Examiner simply states that "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to apply the teaching of Stefik to control the leasing of invokable software objects

because it would enabled the owner of a software object to specify usage and distribution rights to the software object. "

The Examiner has alleged a benefit of combining elements from the various references and relies on that benefit as a motivation to combine the references to achieve the benefit. The mere fact that the references can be beneficially combined is insufficient to provide a motivation to combine without an objective teaching to combine the references. See, MPEP 2143.01. To show that the Examiner did not use hindsight, the Examiner must point out a motivation to combine the references that comes from one of three sources: the nature of the problem to be solved, the teachings of the prior art or the knowledge of persons of skill in the art. *In Re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). It appears the Examiner has relied on none of these and the Examiner provides no explanation regarding how the Examiner derived the proffered motivation. Therefore, it further appears that the Examiner has either alleged a motivation that is not in the references or impermissibly used the benefit of the Applicant's invention as a motivation to combine.

Applicant further submits that the Examiner must show the reasons that a skilled artisan, *with no knowledge of the claimed invention*, would select elements from the references for combination in the manner claimed. See, *In Re Rouffet*, 47 USPQ2d at 1457-1458. The Examiner must provide actual evidence that one of ordinary skill in the art would be motivated to combine the references in the manner claimed. See, *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000) (stating "particular findings must be made as to the reason a skilled artisan, with no knowledge of the claimed invention, would have selected these component for the combination in the manner claimed"). Accordingly, particular findings of the motivation to combine must be shown on the record. *Id* at 1317. The Examiner has not provided any evidence of particular findings of a motivation to combine. Applicant has reviewed the Stefik and Chang disclosures and have been unable to find any teaching, suggestion or motivation in the references that would motivate one of ordinary skill in the art, looking at the references, to combine the references in the manner claimed.

In fact, Applicant respectfully submits that the combination of Stefik and Chang is not obvious to one of ordinary skill in the art. Stefik refers to the usage rights of various digital works, including audio, video and electronically published material. These digital works are eventually distributed to human users, who may have need to further distribute this digital work to other human users, thus human users are granted access rights to the digital works using digital tickets.

In contrast, Chang is directed to a methodology for managing leases on system resources within a distributed computing environment, wherein a resource is a portion of a computer system's physical units, logical units or functionality. These physical or logical units do not have the same usage and distribution patterns of the digital media referred to in Stefik. In distributed computing, a software program that has received use of a logical resource from another resource has no need to further distribute the logical resource (for example to other software programs). These distributed logical resources are a way of executing logic or functionality on one computer, and after that functionality is executed the distributed logical resource is sent back to the computer from which the logical resource originated, or alternatively, the logical resource is released. To control access to the logical resources of Chang with the digital ticket system described in Stefik, would create a complexity and overhead that is not only needless, but that would also be detrimental to the operation of the distributed computer system which is utilized in Chang.

Accordingly, withdrawal of the rejection of independent claim 1 and its associated dependant claims 2-13 is respectfully requested. Additionally, as independent claims 14, 27 and 40 recite limitations similar to claim 1 withdrawal of the rejection of these independent claims and their respective dependent claims 15-26, 28-39 and 41-44 is respectfully requested as well.

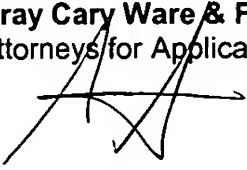
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of claims 1-44. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-0456 of Gray Cary Ware & Freidenrich, LLP.

Respectfully submitted,

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